

## REMARKS

Claims 1-4 were canceled in a prior action. Claims 10-13, 15, and 16 are canceled herein. Such cancellation is without prejudice on the merits to further prosecution of these claims in one or more continuing applications.

Claims 5, 6, 8, and 9 have been amended herein. Claims 8 and 9 have been amended in format only, to clarify the subject matter claimed and to present the various substituents in a more orderly, numerically-ascending, format.

Claim 5 has been amended to draw a clear distinction between the claimed subject matter and the Lenz paper (which was newly cited in the Final Office Action). Claim 6 has been amended solely to synchronize the scope of the R<sup>1</sup> substituent to comport with the corresponding description in Claim 5. The amended recitation of R<sup>1</sup> in Claim 5 is supported by Claim 1 as originally filed. No new matter is added.

This amendment is necessary and was not submitted earlier because the Lenz paper was unknown to the Applicants until it was cited by the Office in the Final Office Action dated April 24, 2007. Thus, Applicants request an opportunity to submit a revised set of claims that account for the newly discovered existence of the Lenz paper. Applicants note that the amendments submitted herein are concise and directly address the points raised by the Office in the Final Office Action. Applicants also note that Claims 10-13, 15, and 16 have been canceled herein, thus greatly simplifying any remaining issues. No new matters are presented for search or consideration on the part of the Office. Thus, entry of this response after final and consideration on the merits is appropriate and is respectfully requested.

### **Rejection of Claims 11-13 Under 35 USC §112, First Paragraph (Enablement):**

This rejection has been rendered moot by cancellation of the claims.

### **Rejection of Claim 8 Under 35 USC §112, Second Paragraph:**

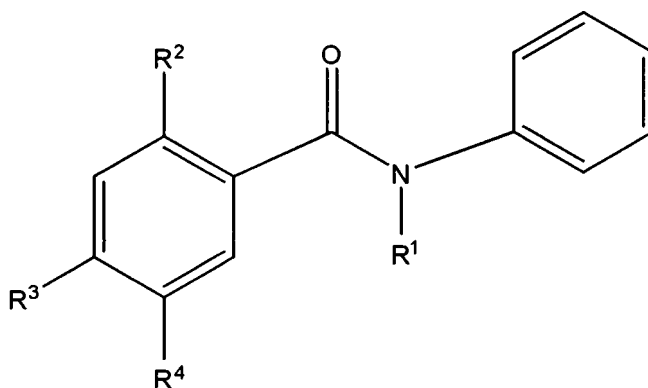
This rejection is believed to have been overcome by appropriate amendment to the claim. The phrase "such that" has been removed from Claim 8, and the various R groups

defined in appropriate Markush-type phrases to convey the meaning intended in the prior wording of the claim.

Withdrawal of the rejection is respectfully requested.

**Rejection of Claim 5 Under §102(b) In View of Lenz:**

This rejection has been overcome by appropriate amendment to the claims. Table II of the Lenz paper describes the following, relevant compounds: (The structure as shown in Lenz' table has been rotated so that it matches the orientation of Formula (I) as presented in the subject claims.)



As shown in the Lenz paper (using Lenz' numbering): R<sup>1</sup> can be hydrogen or methyl, R<sup>2</sup> can be methoxy or methyl acetate, and R<sup>3</sup> and R<sup>4</sup> can be hydrogen or methoxy. Note, however, that the position that corresponds to the R<sup>1</sup> substituent in the present claim (*i.e.*, ring position 6 in the left-hand ring moiety) is **always** hydrogen in the Lenz paper.

In contrast, Claim 5 now positively requires that the R<sup>1</sup> substituent be C<sub>3</sub>- to C<sub>16</sub>-alkyl or C<sub>3</sub>- to C<sub>16</sub>-alkene. Applicants respectfully note that the compounds positively recited in Claim 5 are not disclosed in the Lenz paper. Thus, the rejection of Claim 5 under §102(b) in view of Lenz has been overcome. Withdrawal of the rejection is respectfully requested.

Applicants also note that the compounds now positively recited in Claim 5 are not adjacent homologs of the compounds described by Lenz, and thus are not *prima facie* obvious

in light of the compounds described in the Lenz paper.

**Rejection of Claims 5-8, 10, and 14 Under §103(a) in View of Lenz in Combination with U.S. Patent No. 3,113,067:**

As applied to Claim 10, this rejection has been rendered moot by cancellation of the claim.

As applied to Claims 5-8, and 14, this rejection is believed to have been overcome, in part, by appropriate amendment to the claims, and is, in part, respectfully traversed.

As noted above, Claim 5 has been amended to recite that the R<sup>1</sup> substituent is selected from C<sub>3</sub>- to C<sub>16</sub>-alkyl or C<sub>3</sub>- to C<sub>16</sub>-alkene. Claim 6 has been amended accordingly so that R<sup>1</sup> is selected from n-propyl, isopropyl, n-butyl, t-butyl, C<sub>8</sub>H<sub>18</sub>, C<sub>15</sub>H<sub>26</sub>, C<sub>15</sub>H<sub>28</sub>, C<sub>15</sub>H<sub>30</sub>, and C<sub>15</sub>H<sub>32</sub>.

With respect to the combined teaching of Lenz with the '067 Patent, Applicants respectfully note that '067 Patent also requires that at least one of the R<sup>4</sup> groups described therein be a nitro (-NO<sub>2</sub>) group. Thus, when Lenz is combined with the '067 Patent, the core structure of Lenz must be modified to include both the alkyl group as taught by the '067 Patent, as well as the nitro group that is required by the '067 Patent. In other words, the '067 Patent requires the nitro group. Thus, an appropriate combination of Lenz with the '067 Patent must also include the nitro group, because to modify the teaching of Lenz to exclude the nitro group would surely destroy the utility of the compounds described in the '067 Patent. The present claims, however, do not include any compounds that have a nitro substituent.

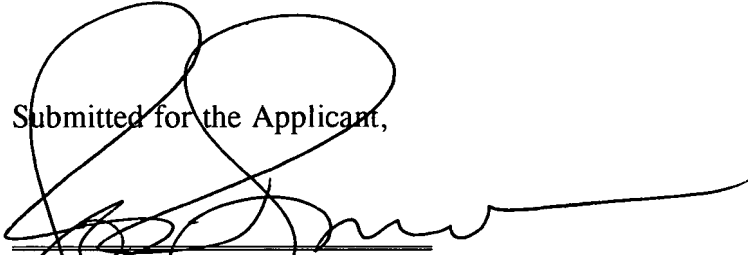
It is well-settled law that a *prima facie* case of obviousness cannot be established where a proposed modification destroys the utility of the applied prior art. In such an instance, there is no technological motivation to make the proposed modification. In the present situation, the combination of Lenz with the '067 Patent necessarily yields Lenz' core structure, with both the alkyl group and the nitro group of the '067 Patent. But, as noted above, the present claims do not encompass nitro-derivative compounds, a substituent pattern that the '067 Patent requires absolutely.

Applicants thus submit that this rejection has been overcome. Withdrawal of the rejection is respectfully requested.

#### CONCLUSION

Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

Submitted for the Applicant,



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